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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,312	09/23/2003	Rene Weber	032498.018	9276
21839	7590	12/06/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			GIBSON, RANDY W	
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			2841	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,312

Applicant(s)

WEBER, RENE

Examiner

Randy W. Gibson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/8/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed November 8, 2004 have been fully considered but they are not persuasive. First of all, applicant argues that none of the references cited disclose or suggest the claim limitation of "said coated surface in relation to said test weight has a first sliding friction and a first adhesive friction that are at least twice as strong, respectively, as a second sliding friction and a second adhesive friction between the test weight and a non-coated, polished surface of an analogous weighing pan made of hard metal." It is unclear if this is a patentable limitation at all since it is not really clear from the context whether it is really the coefficient of friction (μ) or the net force of friction ($F = \mu N = \mu((g \cdot m) \sin \theta)$) that is being referred to by the term "friction" in the claims because no art recognized technical terms are being used; it is also unclear what the phrase "twice as strong" means since no units nor numerical ranges are given, and the word "strong" itself is never defined in technical terms (The numerical ranges given as examples on page 7 of the specification might be referring to the coefficient of friction since no units are given and μ is normally a dimensionless constant; but there is nothing in the written description that expressly says this, and the examiner notes that the word "strong" normally implies a force (usually given in Newtons or ft.-lbs.), not a scalar constant like the coefficient of friction.). Even if the claim was reworded to overcome this problem, it is also clear from Figure 3.2 from "Friction of polymers" (<http://calcul.com/ian/thesis/node22.html>) that irregardless of what type of coating is actually used to coat the test weight, the coefficient of friction itself for a polymer

material (Plexiglas® in this figure) usually varies based on the actual contact force between the two bodies (I.E.: the weight of the test weight) because of a polymer's inherent flexibility. According to this figure, the coefficient of friction μ between "steel on steel" is a little over 0.4 irregardless of contact force, while the coefficient of friction μ of steel on this particular polymer varies between a little over 1.0 to slightly below 0.4 based on the contact force. Two times 0.4 is actually 0.8; since 1.0 is greater than 0.8, it appears that irregardless of what the test weight is actually coated with, any scale pan that has some type of a polymer (plastic) coating will inherently meet this particular limitation of claim 1 -- assuming that the contact force is low enough. The broadest reasonable interpretation of this indefinite claim limitation appears to be fully met by the references and rejections of record since the apparatus claims, when broadly read, are simply reciting a coated scale pan.

Note that references cited to show a universal fact need not be available as prior art before applicant's filing date. *In re Wilson*, 311 F.2d 266, 135 USPQ 442 (CCPA 1962). Such facts include the characteristics and properties of a material or a scientific truism. See *MPEP* § 2124.

Applicant's arguments that the surface coating of Rogello serves a different purposed than the purpose of the claimed surface coating does not seem to be relevant. "[T]he discovery of a previously unappreciated property of a prior art composition ... does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); and, *MPEP* § 2112. The examiner also notes that a recitation of an additional advantage

inherently associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention; see *MPEP* § 2145.

Applicant further argues that the bladder of Chech et al cannot be considered to be a "weighing pan" as defined since the "functionality" of the bladder is "being part of the force-transfer system of the described weighing-system". The examiner notes that all weighing pans are inherently "part of the force-transfer system of the described weighing-system". All weighing pans, almost by definition, have the function of holding a load to be weighed (Applicant himself describes his weighing pan in his remarks as "operable for carrying a load during the weighing process"). Any weighing pan must therefore transfer the weight of the load from the pan itself to a load sensor in order for a weighing scale to be operational; therefore all weighing pans are inherently part of a "load transfer system" of a weighing mechanism. Furthermore, the bladder of Chech et al was designed to be part of the bottom cushion of an automotive seat; the bladder was obviously intended to carry the load to be weighed since the subject being weighed clearly sits upon it (Figs 1, 3, 4, & 5). Therefore, the bladder meets the art recognized definition of a "weighing pan" by any reasonable interpretation of the term. For the record, the examiner actually assumed that the entire bottom seat cushion itself, including the internal bladder, represented the weighing pan, not just the bladder by itself -- as applicant himself latter expressly acknowledges in his remarks. Applicant's conclusory statement that "the Cech et al. patent does not describe any weighing pan within the confines of a reasonable meaning of this term" seems to be contradicted by the figures of this patent itself which clearly shows a person sitting on the seat.

Applicant argues that there is no need to apply a coating on the bladder to increase friction; however, this argument does not seem to be relevant since the examiner never made this assertion. This argument seems moot.

Specification

2. The disclosure is objected to because of the following informalities: it is not really clear from the context whether it is really the coefficient of friction (μ) or the net force of friction ($F = \mu N = \mu((g \cdot m) \sin \theta)$) that is being referred to by the term "friction" in either the claims or the written description since no art recognized technical terms are being used; it is also unclear what the phrase "twice as strong" means since no units nor numerical ranges are given, and the word "strong" itself is never defined in technical terms (The numerical ranges given as examples on page 7 of the specification might be referring to the coefficient of friction since no units are given and μ is normally a dimensionless constant; but there is nothing in the written description that expressly says this, and the examiner notes that the word "strong" normally implies a force (usually given in Neutrons or ft.-lbs.), not a scalar constant like the coefficient of friction.). Appropriate correction is required.

Claim Objections

3. Claims 1-10 are objected to because of the following informalities: it is not really clear from the context whether it is really the coefficient of friction (μ) or the net force of friction ($F = \mu N = \mu((g \cdot m) \sin \theta)$) that is being referred to by the term "friction" in the

claims since no art recognized technical terms are being used; it is also unclear what the phrase "twice as strong" means since no units nor numerical ranges are given, and the word "strong" itself is never defined in technical terms (The numerical ranges given as examples on page 7 of the specification might be referring to the coefficient of friction since no units are given and μ is normally a dimensionless constant; but there is nothing in the written description that expressly says this, and the examiner notes that the word "strong" normally implies a force (usually given in Newtons or ft.-lbs.), not a scalar constant like the coefficient of friction.).

A claim may be rendered indefinite by reference to an object which is variable in a way which is hard for the ordinary practitioner to define or predict. See *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989); and, MPEP § 2173.05(b). It is clear from Figure 3.2 from "Friction of polymers" (<http://calcul.com/ian/thesis/node22.html>) that irregardless of what type of coating is actually used to coat the test weight, the coefficient of friction itself for a polymer material (Plexiglas in this case) usually varies based on the actual contact force between the two bodies (I.E.: the weight of the test weight) because of a polymer's inherent flexibility. According to this figure, the coefficient of friction μ between "steel on steel" is a little over 0.4 irregardless of contact force, while the coefficient of friction μ of steel on a polymer varies between a little over 1.0 to slightly below 0.4 based on the contact force.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Rogallo (US # 3,304,773). Rogallo discloses a scale pan that is coated with a polymer (column 3, lines 3-7).

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Cech et al (US # 5,957,491). Cech et al discloses a weigh pan (12) that is coated with polyurethane (Col. 4, lines 39-44). In response to applicant's argument that the pan is operable to weigh a test weight, it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Obviously, if the seat can hold a normal load, then it can also inherently hold a test weight designed to be placed in the seat for calibration procedures.

In response to applicant's arguments, the recitation that this is a comparator balance has not been given patentable weight because the recitation occurs only in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogallo (US # 3,304,773) in view of Maejima (JP 61-057,660). Rogallo discloses the claimed invention except for the specific type of lacquer claimed. As noted in the International Search Report, Maejima discloses the type of lacquer claimed and states that it has good corrosion resistance. It would have been obvious to the ordinary practitioner to use a known material based on its art recognized suitability for its intended purpose. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ

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297 (1945); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); and, *MPEP* § 2144.07.

9. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cech et al (US # 5,957,491). It is obvious that an automobile seat should have anti-static agents (so that a driver wont shock himself), the seat should be resistant to solvents so it doesn't deteriorate, it should have a coefficient of friction high enough to effectively prevent the driver from slipping off, and should have a sufficient hardness so that it would be puncture resistant. The exact ratios of agents, the specific hardness, etc., would have been optimized by the ordinary practioner through routine experimentation. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); and, *MPEP* § 2144.05(II).

Conclusion

10. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and to clear up any and all objections made above.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamanaka et al show a test weight 15 being placed on a vehicle

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seat for the purposes of calibrating the internal weight sensor. The other newly cited references show calibration weights with various types of coatings.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

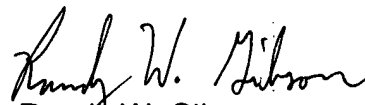
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (571) 272-2103. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Randy W. Gibson
Primary Examiner
Art Unit 2841